

**REMARKS****Status of the Claims**

Upon entry of the amendment above, claims 1-43 will be pending, claims 1, 6, 22, 29, 35, and 38 being independent.

**Summary of the Office Action**

As indicated on the cover page, the Examiner has acknowledged the priority claim and receipt of the certified copy of the priority application. In addition, as evidenced by the Examiner-initialled PTO-1449 form, the Examiner has acknowledged her consideration of Applicants' previously filed information disclosure statement.

Claim 6 is rejected under 35 USC §112, second paragraph, for lacking proper antecedent basis for a particular term.

Claims 1-6 are rejected under 35 USC §102(b) as being anticipated by CAGLIARI (U.S. Patent No. 5,732,483). See Section 3 on page 2 of the Office action.

Claims 1-4 and 7-9 are rejected under 35 USC §102(b) as being anticipated by FERRETTIE (U.S. Patent No. 2,306,306). See Section 4, beginning near the bottom of page 2 of the Office action.

Claim 10 is rejected under 35 USC §103(a) as being unpatentable over FERRETTIE in view of BARRET (U.S. Patent No. 5,940,990) or DONNADIEU (U.S. Patent No. 5,704,138). See Section 6, on page 3 of the Office action.

Claim 11 is rejected under 35 USC §103(a) as being unpatentable over CAGLIARI in view of TOMARO (U.S. Patent No. 5,499,459). See Section 7, on page 3 of the Office action.

**Response to the Office Action****A. Miscellaneous**

Initially, Applicants express their appreciation for the Examiner's consideration of the information disclosure statement and her acknowledgement of Applicants' priority claim and receipt of the certified copy thereof.

**B. Withdrawal of Rejection Under 35 USC §112, Second Paragraph**

In response to the rejection of dependent claim 6 under 35 USC §112, second paragraph, as being indefinite for failing to provide proper antecedent basis for the expression "the collar," Applicants have amended claim 6 by rewriting it in independent form. In so doing, they included the subject matter of claim 5, inasmuch as claim 5 includes the term "collar." Accordingly, antecedent basis has now been provided.

In response to the amendment, reconsideration and withdrawal of the rejection is requested.

While amending claim 6, Applicants noted that the expression "the lateral tightening flaps" did not appear to have proper antecedent basis in claim 6. Accordingly, that expression has also now been introduced into claim 6.

**C. Withdrawal of Rejection Under 35 USC §102(b) Based Upon CAGLIARI and Under 35 USC §103(a) Based Upon CAGLIARI in View of TOMARO**

Applicants respectfully traverse the rejection of claims 1-6 under 35 USC §102(b) as being anticipated by CAGLIARI and the rejection of claim 11 under 35 USC §103(a) as being unpatentable over CAGLIARI in view of TOMARO.

The boot of the invention recited in independent claim 1 includes three parts, viz., a sole, an outer upper having an impervious portion, and an outer reinforcing element that is cemented to the impervious portion of the upper.

CAGLIARI's snowboard boot includes *two* parts, rather than three, whereby the sole (element 4 of CAGLIARI according to the rejection) and the reinforcing element (element 3 of CAGLIARI according to the rejection) are made as a single unitary piece. Fig. 4 of CAGLIARI illustrates the sole/reinforcement which is flush-fitted onto the upper (seen in Fig. 3).

In Applicants' invention, the reinforcement (except for the embodiment shown in Fig. 5, *e.g.*) is cemented to the upper and, in that sense, becomes part of the upper and not part of the sole. In either case, the reinforcement is not a part of the sole as in CALIGARI.

In fact, CALIGARI describes his invention as being "composed of *two* main parts, namely the upper (2) and the sole (3)." (emphasis added). See column 2, lines 65-67. Further, CALIGARI explains (in column 1, lines 51-53) that "in contrast to all existing types of snowboarding boots, the tightening of the upper onto the foot bears directly on the sole instead of on the upper." Further, in this regard, CALIGARI explains that "the invention consists in tightening the upper directly on to the sole."

At least for the foregoing reason, Applicants submit that the rejection based upon CALIGARI be withdrawn.

Further, Applicants acknowledge that it is known per se to glue a sole onto an upper and to have parts of the sole cover a portion of the upper, as shown by CALIGARI.

However, the concept of gluing, rather than stitching, parts of the upper together is new and is in contradiction with the general knowledge and know-how of one skilled in the art of the footwear industry. For such skilled artisan, *i.e.*, technician, the upper parts of a shoe are only assembled by stitching, it being a simple and fast method of assembly.

When a waterproof construction is needed, then a waterproofing tape is applied on all seams at the back of the seam inside the upper.

According to the invention, on the other hand, the parts of the upper are assembled together simply by gluing in areas that are to be waterproofed. This feature is new, not disclosed by CALIGARI, and is contrary to the know-how of a technician in the footwear technology.

Further, Applicants' claim 6 calls for the collar and the lateral tightening flaps to comprise "the only means for tightening the upper."

By contrast, CALIGARI includes elements 30 on each side of the upper 2 which *also* act to tighten the upper. See column 3, line 63, to column 4, line 9 of CALIGARI.

In view of this additional difference, reconsideration and withdrawal of the rejection of claim 6 is requested.

Lastly, Applicants request that the rejection of claim 11 as being unpatentable over CAGLIARI in view of TOMARO be withdrawn at least for the reasons given above with regard to claim 1, TOMARO not including a teaching relating to such reasons.

**D. Withdrawal of Rejection Under 35 USC §102(b) Based Upon FERRETTIE and Under 35 USC §103(a) Based Upon FERRETTIE in View of BARRET or DONNADIEU**

Applicants respectfully traverse the rejection of claims 1-4 and 7-9 under 35 USC §102(b) as being anticipated by FERRETTIE and the rejection of claim 10 under 35 USC §103(a) as being unpatentable over FERRETTIE in view of BARRET or DONNADIEU.

FERRETTIE discloses a leather boot that is covered with a rubber foot portion. It appears to include at least the following three elements: a sole 17, an outer upper 11 made of leather (relied upon as an "impervious portion"), and an outer portion 19 cemented to the upper 11 (relied upon as a "reinforcing portion").

First, Applicants submit that, without any description in FERRETTIE to support the rejection, the fact that the upper of FERRETTIE is made of leather is not necessarily probative of whether the upper is impervious, *i.e.*, resistant to the penetration of water. Although Applicants mention, in paragraph [0009] of their specification, that leather can be an impervious material, one skilled in the art would recognize that there are various different grades of leather having varying characteristics, including leathers that are necessarily coated or treated with a waterproofing layer to obtain imperviousness. In short, leather is not necessarily an impervious material.

Even if it were the intent of FERRETTIE to disclose a type of boot intended to be used in snow, *e.g.*, or otherwise to be waterproof, Applicants submit that it would be important that the bottom, or rubber, portion 10 be made waterproof, although it is not clear that the top (leather) portion 11 be made waterproof, at least for breathability reasons. In any event, there is not teaching in FERRETTIE regarding this.

Further, rubber wall 19 is not a reinforcing element necessarily, inasmuch as, other than the overlap shown at the stitched seam, there is no upper part that is to be covered or reinforced by the rubber wall 19, *i.e.*, the rubber foot portion 10. That is, the boot upper is formed of two successive parts, *viz.*, a leather top portion 11 and a rubber foot portion 10 attached thereto. For example, see column 2, lines 15-18 of FERRETTIE.

By contrast, not only is Applicants' outer upper reinforced by the reinforcing portion, the upper extends downwardly to the sole.

At least for the foregoing reasons, reconsideration and withdrawal of the rejection of claim 1 is requested.

Regarding claim 3, which calls for the reinforcing element to comprise "lateral tightening flaps," the rubber foot portion 10 of FERRETTIE's boot does not include lateral tightening flaps. Merely the "sides" of FERRETTIE's boot cannot be fairly interpreted as constituting "flaps" in the ordinary and customary meaning of the term.

Regarding claim 7, which is directed to having "each of said at least one outer seam being covered by a cemented reinforcing element," in FERRETTIE the purpose of covering the seams 21, 22 is not a waterproof problem, although the wall 19 of the rubber foot portion 10 could provide waterproofing. Instead, the seams are covered to avoid a scuffing of the stitches (see column 1, lines 28-32 and 49-50).

Lastly, Applicants request that the rejection of claim 10 as being unpatentable over FERRETTIE in view of BARRET or DONNADIEU be withdrawn at least for the reasons given above with regard to parent claims 7 and 10, BARRET nor DONNADIEU not including a teaching relating to such reasons.

Further, neither BARRET nor DONNADIEU teach or suggest the problem nor the need for waterproofing the seams of an internal tightening mechanism. In this regard, such tightening systems are normally not fixed to the upper but assembled to the shoe in the sole mounting area (regarding BARRET, note column 3, lines 45-49) and, thus, they are normally independent of the outer upper.

### **E. New Claims**

In the amendment above, Applicants have added new claims 12-42, which are believed to be patentably distinct from the documents of record.

Of the new claims, claims 22, 29, 35, and 38 are independent.

Independent claim 22 includes subject matter similar to that of original claim 1, but emphasizes a feature of the invention whereby the upper includes a plurality of parts, such as a cemented reinforcing element to cover and render impervious outer seams of the upper in an impervious portion of the upper. As mentioned above, CAGLIARI teaches the gluing of an upper to a sole, but does not disclose cementing a reinforcing element over a stitched seam. Further, as mentioned above, it is not clear that FERRETTIE discloses an upper with an impervious upper, nor a reinforcing portion for the upper. The rubber foot portion 10 of FERRETTIE only overlaps the upper 11 at the seam with wall 19 and, because the foot portion 10 is made of rubber, Applicants submit that it cannot be fairly regarded as reinforcing an upper.

Independent claim 29 is directed to a boot according to the invention, whereby a plurality of upper parts are securely assembled together *only by the application of cement*. Stitching is not relied upon to assemble parts of the upper. As mentioned above, CAGLIARI teaches the gluing of an upper to a sole, but does not disclose cementing a plurality of upper parts together only by with an application of cement. Further, FERRETTIE relies upon vulcanization to bond the parts together, such as the rubber wall 19 to the leather upper 11. See, *e.g.*, page 2, left column, lines 10-12 and 55-74. Although an adhesive is applied in FERRETTIE before vulcanization, in a pre-assembly step, it is the vulcanization that bonds the parts together. Note page 2, left column, lines 69-74: "... when thus vulcanized all of the cemented parts are securely bonded together and the leather upper inseparably secured to the rubber foot portion."

Independent claim 35 includes subject matter of original claim 1, part of claim 6, and claim 7. Thus, a tightening mechanism comprising the lateral tightening flaps, *i.e.*, laterally

*spaced-apart* tightening flaps, is the *only* means for adjustably tightening the upper around the foot of the wearer. This cannot be said of the boots of either CAGLIARI or FERRETTIE. In addition, claim 35 includes a cemented reinforcing element covering an outer stitched seam, as specified in claim 7, which had not been rejected over CAGLIARI.

Independent claim 38 includes a recitation of the three parts of the boot, *i.e.*, the sole, the outer upper, and the reinforcing element, that the reinforcing element includes laterally spaced apart tightening flaps (not taught or suggested by FERRETTIE), and that the tightening flaps have a front end spaced from the front end of the boot (not taught or suggested by either FERRETTIE or CAGLIARI).

In addition to the new independent claims, Applicants have added a number of dependent claims.

Claims 12, 14 (as does independent claim 35) describe a feature of an embodiment of the invention whereby the collar and the lateral tightening flaps are the only means for tightening the upper.

Dependent claims 15, 27, and 37 specify that the impervious portion of the outer upper extends downwardly to the sole of the boot. In contrast, in FERRETTIE, the upper 11 only extends down to the seam with the rubber foot portion 10.

Dependent claims 16, 18, 21, 23, and 32 call for the outer upper to include a coating to effect the imperviousness of the impervious portion.

Dependent claims 17, 28, and 29 call for the outer reinforcing element to be assembled to the upper only by the application of cement. No stitching and no vulcanization is encompassed by these claims.

Like independent claim 38, dependent claims 25 and 33 call for the laterally spaced apart tightening flaps to have a forward end that is spaced from a front end of the boot.

Dependent claims 31 and 41 call for the cement to be located in a cementing zone extending from the sole to substantially mid-height of the upper.

**F. Amendment of the Specification**

Finally, Applicants have amended the specification above for the purpose of correcting informalities. No prohibited new matter has been added.

**SUMMARY AND CONCLUSION**

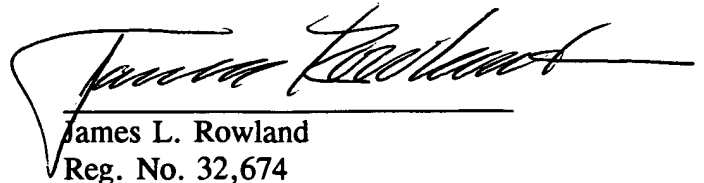
The grounds of rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

A check is enclosed for payment of a claim fee. No additional fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Further, although no extension of time is believed to be necessary at this time, if it were to be found that an extension of time were necessary to render this reply timely and/or complete, Applicants request an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) to render this reply timely and/or complete and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,  
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